



# Wiener & Associates

INTELLECTUAL PROPERTY LAW

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File No. INGA,004

November 8, 2001

Commissioner of Patents and Trademarks  
Washington, DC 20231

Re: Application of: Charles A. Conrad  
Serial No.: 09/169,793  
Filed: October 9, 1998  
For: **PRODUCTION OF ssDNA *IN VIVO***

Dear Sir:

Enclosed for filing in connection with the captioned application is/are the following:

- Response to Official Action of May 8, 2001;
- Request for [Three Month] Extension of Time to Respond; and
- Check in accordance with the requirements of 37 C.F.R. §§ 1.117(a)(3).

The Commissioner of Patents is hereby authorized to draw on the Deposit Account of Wiener & Associates, Account No. 50-0965 (INGA,004), if there are fees associated with this filing and/or if any required fees enclosed are insufficient, the check is unsigned, or if fees are inadvertently not enclosed. Please return the enclosed self-addressed, postage-prepaid postcard evidencing receipt of the above documents.

Respectfully submitted,

Mark R. Wisner  
Attorney for Applicant  
Registration No. 30,603

MRW/lin  
Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of:  
Charles A. Conrad

Serial No.: 09/169,793

Filed: October 9, 1998

For: **PRODUCTION OF  
ssDNA IN VIVO**

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Atty. Docket No.:

INGA

Examiner:

J. Martinell

Group Art Unit:

1633

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12/31/01  
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COMMISSIONER OF PATENTS  
AND TRADEMARKS  
WASHINGTON, D.C. 20231

**CERTIFICATE OF MAILING (37 CFR 1.8a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date indicated below with sufficient postage as first class mail in an envelope addressed to the Commissioner of Patent and Trademarks, Washington, D.C. 20231.

Mark R. Wisner, Registration No. 30,603

November 8, 2001  
Date

**RESPONSE TO OFFICIAL ACTION OF MAY 8, 2001**

Dear Sir:

Applicant responds to the Official Action mailed in the captioned application on May 8, 2001 as follows. A request for a three month extension of the time to respond to that Action, and a check for the applicable fee, is enclosed. In the event the check in the amount of any necessary fees was not properly executed, was not included with this Response and/or was insufficient in amount, or for any other reason this Response is not considered timely filed, request is hereby made for an extension of the time for the period necessary to ensure consideration of this Response and the Commissioner is authorized to charge Deposit Account No. 50-0965 (INGA,004) in the amount of any necessary fee.

**REMARKS**

In the Official Action of May 8, 2001, the claims were rejected under 35 U.S.C. 102(a) and (e) as being "clearly anticipated by any one of" the Mirochnitchenko, *et al.*, Miyata, *et al.*, or Inouye, *et al.* references. These rejections are respectfully traversed. Although it is alleged in the Action that these references "clearly anticipate" the claims of the present application, it is not so clear to the Applicant that they anticipate the claims at all. The Rules of Practice require that

In rejecting claims for want of novelty . . . , the examiner must cite the best references . . . [and] when a reference is complex . . . that particular part relied upon must be designated as nearly as practicable." 37 C.F.R. 1.106(b).

Although the Office Action cites, for instance, the "Results and Discussion" section of Mirochnitchenko, *et al.*, pages 4-10 of Miyata, *et al.*, and pages 5-14 of Inouye, *et al.*, in making